

**REMARKS**

Claims 1-18 are pending in this application. By this Amendment, claims 1 and 17 are amended. No new matter is added.

**I. Personal Interview**

The courtesies extended to Applicants' representative by Examiner Van Pelt and Examiner Bucci at the interview held April 6, 2004, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below and constitute Applicants' record of the interview.

**II. Claim Rejections Under 35 U.S.C. §103**

Claims 1-4 and 8-15 are rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,847,471 to Morishita et al. (Morishita). The rejection is respectfully traversed.

As discussed and agreed during the personal interview, Morishita does not disclose or suggest each and every feature recited in the rejected claims as amended. For example, Morishita does not disclose or suggest a starter for an internal combustion engine including a planetary gear speed reduction mechanism, a pinion to be engaged with a ring gear of the engine and a pinion drive shaft connected to the speed reduction mechanism comprising *inter alia* a motor housing with a first outside diameter and a motor shaft, a front housing for supporting the pinion drive shaft, the front housing having a bearing for supporting the pinion drive shaft at one end of the shaft, and an integrally formed and radially-outwardly extending flange for providing a plurality of fastening holes disposed at a circumference having a second diameter through which a plurality of fastening bolts is fixed to a portion of the internal combustion engine, and a center casing having approximately the same outside diameter as the motor housing and a bearing for supporting the pinion drive shaft at the other end, the center casing being disposed between the motor housing and the front housing for

aligning the motor shaft, the planetary gear speed reduction mechanism and pinion drive shaft, . . . wherein . . . the adjusting means comprises a first number of female screw holes formed at an end of the center casing, a second number of through holes, which number is smaller than the first number, formed at an end of the front housing in contact with the end of the center casing and a plurality of bolts that screw into those of the female screw holes that are selected to adjust the front housing to the selected angular position.

As shown in Fig. 3 of Morishita, a flange member 32 is fixed to an overhang-type front housing 21. The front housing of Morishita supports a pinion drive shaft 25 at its opposite ends by a pair of bearings. Thus, the alleged center casing ("section between 32 and 22") in Morishita is integrally formed with the overhang-type front housing 21 of Morishita. The flange member 32 in Morishita neither has a bearing for supporting the pinion drive shaft 26, nor aligns the motor shaft 23a, the planetary gear speed reduction mechanism 28, and pinion drive shaft 26. Accordingly, the flange 32 of Morishita is entirely different from the center casing recited in the pending claims.

The Office Action also alleges that the motor housing 22 (yoke) of Morishita has a first outside diameter and that the front housing 21 has a circumference having a second diameter through which a plurality of fastening bolts are fixed to a portion of the internal combustion engine. However, as clearly shown in the figures of Morishita, the housing 21 has a diameter that is much larger than that of the yolk 22 which corresponds to the motor housing recited in the claims. Thus, Morishita does not disclose the motor housing (yoke 22) having approximately the same outside diameter as the center casing (front housing 21).

The Office Action further alleges that a portion of the front housing 21 forms the center casing which corresponds to the center casing recited in the claims. The Office Action then alleges that the screws 33 disclosed in Morishita correspond to the claimed adjusting means. However, the adjusting means recited in the claims is "for fixing the front housing to

a selected angular position of the center casing". In contrast, the alleged adjusting means 33 are screws that screw into the holes 21a disposed in the front housing/center casing 21. Accordingly, such screws do not fix the front housing to the center casing as the Office Action alleges that the center casing and the housing are the same piece.

Applicants submit that the screw 33 in Morishita actually fastens the flange portion 32 to the front housing 21. Thus, Morishita does not disclose an adjusting means for fixing the front housing to a selected angular position of the center casing.

Furthermore, Morishita does not disclose that the adjusting means (screw 33 of Morishita) comprises a first number of female screw holes formed at an end of the center casing i.e., housing 21, a second number of through holes, which is smaller than the first number, formed at an end of the front housing (i.e., front housing 21) in contact with said center casing. As discussed above, if the center casing and the housing are the same element, then the front housing is not formed in contact with the end casing i.e., two separate elements in contact with one another.

The Office Action admits that Morishita does not disclose an integrally formed and radially outward extending flange. However, the Office Action alleges that it would have been obvious to one of ordinary skill in the art to form the flange 32 of Morishita integral with the front housing 21 and then separate the front housing from the center housing of Morishita since "it has been held that forming in one piece an article which has formally been formed in two pieces and put together and constructing a formally integral feature in various elements involves only routine skill in the art."

Applicants submit that even were it obvious to one of ordinary skill in the art to form the flange integral with the front housing, such motivation does not carry over to then provide a separate center housing to allow the front housing to be adjustably attached to the center

housing. Accordingly, Applicants respectfully request the rejection of claims 1-4 and 8-18 under 35 U.S.C. §103(a) be withdrawn.

Claims 5-7 are rejected under 35 U.S.C. §103(a) as unpatentable over Morishita in view of U.S. Patent No. 4,325,265 to Wakatsuki et al. (Wakatsuki). The rejection is respectfully traversed.

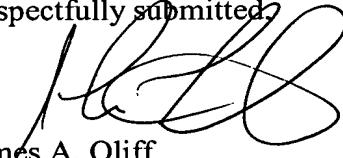
Applicants submit that neither Morishita nor Wakatsuki whether considered alone or in combination disclose each and every feature recited in the rejected claims. Additionally, claims 5-7 are allowable for at least their dependency on independent claim 1 for the reasons discussed above, as well as for the additional features recited therein. Furthermore, Wakatsuki does not overcome the deficiencies of Morishita as described above. Thus, Applicants respectfully request the rejection of claims 5-7 under 35 U.S.C. §103(a) be withdrawn.

**III. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-18 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

  
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